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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,629	07/17/2003	Joseph T. O'Brien	65783-0029	1873

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

12
Office Action Summary

Application No.

10/621,629

Applicant(s)

O'BRIEN ET AL.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/17/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restatement of Election Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 and 17-28, drawn to a plug/pillar shield, classified in class 403, subclass 326.
- II. Claims 13-16, drawn to process for using a plug to secure a wire harness, classified in class 264, subclass 272.14.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using a plug, as described in claims 13-16, can be accomplished using a product other than the plug/pillar shield described in claims 1-12 and 17-28. For instance, a multi-piece plug having coil springs, rather than stabilizers or tensioners, to provide resilient engagement.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Response to Election

Applicant's election with traverse of Group I, Claims 1-12 and 17-28, in the paper filed on 12/22/2004, is acknowledged. The traversal is on the ground(s) that the product cannot be

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made by another materially different process. The Examiner agrees that the description of why the inventions are distinct was misstated in the previous Office Action. However, a proper statement of the reason for distinctness has been provided above without change to the requirement itself.

The requirement is still deemed proper and is therefore made FINAL.

Claims 13-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the paper filed on 12/22/2004.

Claim Objections

Claims 17, 25 and 27 are objected to because of the following informalities:

- Claims 17, 25 and 27 recite numerous elements ambiguously as being both positive structure and functional structure only intended to be used. For instance claim 17 recites a “pillar” as a structure only intended to be used in line 1 and then recites the “the [pillar] wall” as positive structure in line 5. Each element of a claim should be consistently referred to either positively or functionally throughout. For purposes of examination, the Examiner has considered the claims without combination.

Appropriate correction is required. For purposes of examining the instant invention, the Examiner has assumed these corrections have been made.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-12, 17-21 and 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizusawa (U.S. Patent 4,488,206).

Claim 1. Mizusawa discloses (figs.3) a plug (1) inserted into and enclosing an opening (6) within a wall (wall of 5) of a hollow post (5) and securing a wire harness (13) running within the hollow post, comprising: at least two locks (left side 14, right side 14) projecting out from a surface of the plug and securing the plug within the opening, at least one of the locks (right 14) being located at or near a first end (right end of 1) of the plug, and at least one of the locks (left 14) being located at or near a second end (left end of 1) of the plug within the opening along a first axis (axis connecting left 14 and right 14); at least two tensioners (top left 14; bottom left 14) projecting out from the surface of the plug and resiliently engaging the edge of the opening and aligning the plug within the opening along a second axis (axis connecting top left 14 and bottom left 14), at least one of the tensioners (top left 14) being located at or near a first edge (top edge of 1) of the plug, and at least one of the resilient tensioners (bottom left 14) being located at or near a second edge (bottom edge of 1) of the plug; at least one stabilizer (12) projecting out from the surface of the plug and resiliently engaging the wall, thereby exerting tension within the plug along a third axis (axis between 1 and 5); and at least one fastener (2 and ends of 13) for securing the wire harness to the plug.

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Claim 2. Mizusawa discloses that the first and second axes are approximately perpendicular to one another (side to side and top to bottom).

Claim 3. Mizusawa discloses that the third axis (running between 5 and 1 in and out) is perpendicular to said first and second axes.

Claim 4. Mizusawa discloses that the first and second ends of the plug lie opposite to one another, and the first and second edges of the plug lie opposite to one another.

Claim 5. Mizusawa discloses that the hollow post is a pillar of an automobile.

Claim 7. Mizusawa discloses that at least one stabilizer comprises a pair of resilient protrusions extending out from the surface of the plug.

Claim 8. Mizusawa discloses at least two stabilizers (top wall of 12, bottom wall of 12), with at least one of the stabilizers located near the first edge of the plug, and at least one of the stabilizers located near the second edge of the plug.

Claim 9. Mizusawa discloses that the fastener comprises at least one clip (clips at top of 13 as seen in fig.3) that projects out from the surface of the plug and secures the wire harness.

Claim 10. Mizusawa discloses that the fastener comprises a tie (tie portion of 13, as seen in fig.9, as wrapping around two left portions of 13 and attaches to 1) that wraps around the wire harness and then attaches to the plug.

Claim 11. Mizusawa discloses that each of the at least two locks initially engages the edge of the opening with a generally rounded end portion (generally rounded end portions of left side 14 and right side 14) that promotes alignment of the plug respective to the opening.

Claim 12. Mizusawa discloses that each of the at least two tensioners initially engages the edge of the opening with a generally rounded end portion (generally rounded end portions of top left 14 and bottom left 14) that promotes alignment of the plug respective to the opening.

Claim 17. Mizusawa discloses (fig.3) a pillar shield for securing a wire harness running within a pillar, comprising: a generally planar-shaped body (1) designed to close off an opening within a wall of the pillar; at least two clips (left side 14 and right side 14) projecting out from the body of the pillar shield and securing the pillar shield within the opening in the wall, the at least two clips resiliently compressed by an edge of the opening, thereby aligning the pillar shield within the opening along a first axis (axis running though left side 14 and right side 14); at least two tensioners projecting out from the body of the pillar shield, the at least two tensioners (top left 14 and bottom left 14) resiliently compressed by the edge of the opening, thereby aligning said pillar shield within the opening along a second axis (axis running through top left 14 and bottom left 14); at least two stabilizers (top wall of 12 and bottom wall of 12) projecting out from the body of the pillar shield, the at least two stabilizers resiliently compressed by the wall of the pillar, thereby generating tension, directed along a third axis (axis running from 1 to 5), between the pillar shield and the wall of the pillar; and at least one fastener (2 and ends of 13) for attaching the wire harness to the pillar shield.

Claim 18. Mizusawa discloses that the first axis lies approximately ninety degrees from the second axis.

Claim 19. Mizusawa discloses that the third axis lies perpendicular to the first and second axis.

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Claim 20. Mizusawa discloses that at least one of the clips is located at an end (left end of 1) of the pillar shield, and at least one of the clips is located at an opposite end (right end of 1) of the pillar shield.

Claim 21. Mizusawa discloses that at least one of the tensioners is located nearby an edge (top edge of 1) of the pillar shield, and at least one of the tensioners is located nearby an opposite edge (bottom edge of 1) of the pillar shield.

Claim 23. Mizusawa discloses that the fastener comprises at least one clip (portion of 13, as seen in fig.9, clipping onto the two left portions of 13) projecting out from the body of the pillar shield and securing the wire harness.

Claim 24. Mizusawa discloses that the fastener comprises a tie (tie portion of 13, as seen in fig.9, as wrapping around two left portions of 13 and attaches to 1) that wraps around the wire harness and then attaches to the pillar shield.

Claim 25. Mizusawa discloses (fig.3) a pillar shield (1) for securing a wire harness running within a pillar, comprising; a generally planar-shaped body designed to close off an opening within a wall of the pillar; at least two clips projecting out from the body (left side 14 and right side 14) of the pillar shield and securing the pillar shield within the opening in the wall, the at least two clips resiliently compressed by an edge (left and right edges of opening) of the opening, thereby aligning the pillar shield within the opening along a first axis (axis from left to right); at least two stabilizers (top left 14 and bottom left 14) projecting out from the body of the pillar shield, the at least two stabilizers resiliently compressed by the wall of the pillar, thereby generating tension, directed along a second axis (axis running through top left 14 and bottom left

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14), between the pillar shield and the wall of the pillar and at least one fastener (ends of 13 and 2) for attaching the wire harness to the pillar shield.

Claim 26. Mizusawa discloses that the first axis lies approximately ninety degrees from the second axis.

Claim 27. Mizusawa discloses (fig.3) a pillar shield (1) for securing a wire harness running within a pillar, comprising: a generally planar-shaped body (1) designed to close off an opening (6) within a wall of the pillar; at least two clips (left side 14 and right side 14) projecting out from the body of the pillar shield and securing the pillar shield within the opening in the wall, the at least two clips resiliently compressed by an edge (left edge and right edge of 6) of the opening, thereby aligning the pillar shield within the opening along a first axis (axis running left to right); at least two tensioners (top left 14 and bottom left 14) projecting out from the body of the pillar shield, the at least two tensioners resiliently compressed by the edge of the opening, thereby aligning the pillar shield within the opening along a second axis (axis from top to bottom); and at least one fastener (2 and ends of 13) for attaching the wire harness to the pillar shield.

Claim 28. Mizusawa discloses that the first axis lies approximately ninety degrees for the second axis.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizusawa (U.S. Patent 4,488,206) in view of the Applicant's admitted prior art (Figures 1 and 2).

Claims 6 and 22. Mizusawa does not disclose that the plug/pillar shield is a one-piece monolithic structure. The Applicant's admitted prior art (figs. 1 and 2) illustrates that one-piece monolithic structure plugs/pillar shields (200) are old and well known in the art. It has generally been recognized that one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Accordingly, it would have been obvious to one of ordinary skill in the art to modify Mizusawa plug/pillar shield to be of one-piece monolithic structure, since such practice is old and well known in the art and since it is a design consideration within the skill of the art.

Allowable Subject Matter

The Examiner suggests amending the last line of claim 1 to include the limitation --wherein the at least two tensioners and two of the at least two locks are hook shaped leaf springs; and wherein the at least one stabilizer includes at least two tab shaped leaf springs

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extending in substantially opposite directions from one another--. This limitation, when taken in combination with the existing claim 1 limitations, is not disclosed or suggested by the prior art.

MPEP §608 states that amendments that find basis in any part of the disclosure (Specification, Claims or **Drawings**), as originally filed, are not considered to present new matter (emphasis added). Note that elements (400, 500, 600) as shown in the figure 3 of the drawings are easily recognizable as leaf springs in the art. As such the drawings provide support for the above-mentioned leaf spring terminology.

MPEP §608.01(o) states “While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims”. Therefore, if the applicant elects to amend the claims in accordance with the examiner’s suggestion, the specification should also be amended to provide antecedent basis for the leaf spring terminology.

Conclusion

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Referring to plugs:

Ishikawa (U.S. Patent 5,816,733)

Tanaka (U.S. Patent 4,379,648)

Hayashi (U.S. Patent 4,629,356)

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Dzurko (U.S. Patent 6,116,807)

Botts (U.S. Patent 4,755,109)

Irish (U.S. Patent 5,615,584)

Daoud (U.S. Patent 5,868,362)

Lee (U.S. Patent 4,485,282)

Nordstrom (U.S. Patent 5,505,103)

Idjakiren (U.S. Patent 5,039,040)

Makihara (U.S. Patent 3,967,050)

Baum (U.S. Patent 5,291,639)

Malmanger (U.S. Patent 5,358,291)

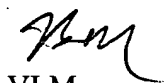
Antonucci (U.S. Patent 6,305,725)

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701.

The Examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



VLM
March 16, 2005



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